

No new matter is added in any of the above amendment. The Examiner is respectfully requested to enter the amendments and reconsider the application.

Remarks

1. Provisional double patenting rejection

Claim 45 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 43 of copending Application No. 09/359,297.

Claim 45 is also provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 45 of copending Application No. 09/359,305.

Claims 32-70 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 41, 43-45 and 57 of copending Application No. 09/359,301. Applicants assume that the rejected claims are 45-70 instead of 32-70.

Applicants will address those provisional double-patenting rejections upon indication of allowable subject matter in the instant application.

2. 35 U.S.C. § 112, second paragraph rejection.

Claims 45-70 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 46-57 are canceled. The rejection of the remaining claims is traversed in view of the amendments.

The Examiner states that Claim 45 is vague and indefinite in that there is no clear and positive prior antecedent basis for the term "said one or more changes" in step (f) of each claim. Applicants respectfully submit that the antecedent basis of "said one or more changes" can be found in step (d), which recites determining one or more phenotypic or biochemical changes in said plant host.

The Examiner states that Claims 45 is vague and indefinite in that the metes and bounds of the phrase "identifying a trait associated with said one or more phenotypic or

biochemical changes" are unclear. Applicants do not agree with the Examiner's statement. However, to further the prosecution, Applicants have deleted the phrase.

The Examiner states that Claim 45 is vague and indefinite in that there is no clear and positive antecedent basis for the term "said trait" in line 2 of step (g) of Claim 45. Applicants have amended Claim 45 to delete the phrase.

Therefore, the §112, second paragraph, rejection of claims 45, and 58-70 should be withdrawn.

3. 35 U.S.C. § 112, first paragraph rejection.

(a) Claims 57-70

Claims 57-70 are rejected under 35 U. S. C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner states that there is no support in the specification as filed for the specific limitation of determining the positive sense orientation of an unidentified nucleic acid following the determination of a trait associated with biochemical or phenotypic change upon expression of the unidentified nucleic acid.

Claim 57 is cancelled. Claims 58-70 are amended to depend upon Claim 45. Therefore, the §112, first paragraph, rejection of Claims 58-70 should be withdrawn.

(b) Claims 45-70

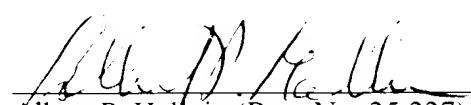
Claims 45-70 are rejected under 35 U. S. C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner states that each of the rejected claims comprises the following limitation "until at least one nucleic acid associated with said trait is identified, whereby a positive sense functional gene profile of said plant host or said donor organism is compiled," and there does not appear to be support in the specification for this specific limitation.

CONCLUSION

In view of the foregoing amendments and remarks, the Applicants believe the application is in good and proper condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is encouraged to call the undersigned at (650) 463-8109.

Respectfully submitted,

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